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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,408	06/15/2000	Joey L. Erickson	33012/292/101	9110
27516	7590	12/16/2008		
UNISYS CORPORATION			EXAMINER	
Unisys Way			SWEARINGEN, JEFFREY R	
Mail Station E8-114			ART UNIT	PAPER NUMBER
Blue Bell, PA 19424			2445	
			MAIL DATE	DELIVERY MODE
			12/16/2008	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/594,408

Filing Date: June 15, 2000

Appellant(s): ERICKSON ET AL.

Wayne A. Sivertson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/4/2008 appealing from the Office action mailed
11/14/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,790,809	Holmes	08-1998
5,758,351	Gibson	05-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5 and 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-5 and 16-20 are directed to software *per se*, and not towards any embodiment of hardware. Claims 1-5 are directed to a data processing system comprising two client work stations, an enterprise server, and a generic gateway. All of these embodiments are described in the specification as being inclusive of software embodiments, and are not limited to hardware embodiments. Claims 16-20 are the equivalent means plus function claims of claims 1-5, and as such also use the structure in the specification which is not limited to hardware embodiments and allows for software embodiments to exist.

Claims 1-3, and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Holmes (U.S. Patent No. 5,790,809).

In regard to claim 1, Holmes discloses *a first user terminal for entering a first transaction request, wherein said first transaction request has a first one of a plurality of protocols* (Holmes, column 3, lines 15-21), *responsively coupled via a publicly available digital communication network to an enterprise server for responding to said first transaction request using an enterprise protocol which is not one of said plurality of protocols* (Holmes, column 3, lines 7-17, lines 28-38) *the improvement comprising: a. a second user terminal for entering a second transaction request wherein said second transaction request has a second one of said plurality of protocols which is different from said first one of said plurality of protocols responsively coupled to said enterprise server via said publicly available digital communication network; and b. a generic gateway interposed between said first user terminal and said enterprise server and*

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between said second user terminal and said enterprise server which responsively couples said first user terminal and said second user terminal to said enterprise server by converting said first one and said second one of said plurality of protocols to said enterprise protocol. Applicant has claims a system that changes a protocol to another protocol for transmission over a network and then converts it to a third protocol for delivery. Holmes, column 3, discloses using a Registry program to accept requests under a protocol for a client application, encapsulating them and converting into a proprietary protocol, and delivering to the server application by converting from the proprietary protocol to a message recognizable to the server application. The process works in reverse for sending a message from the server to the client. See Holmes, column 3, lines 6-48.

In regard to claim 2, Holmes is applied as in claim 1. Homes further discloses *a plurality of adapters interposed between said generic gateway and said first user terminal and said second user terminal which responsively couples said first user terminal to said generic gateway via a first one of said plurality of adapters which corresponds to said first one of said plurality of protocols and which responsively couples said second user terminal to said generic gateway via a second one of said plurality of adapters which corresponds to said second one of said plurality of protocols.* Each transmission on a network would inherently be send using a port in affiliation with a particular protocol, based on basic TCP/IP theory. Using a port would be using an adapter.

In regard to claim 3, Holmes is applied as in claim 2. Holmes further discloses *said publicly available digital communication network further comprises the internet.* See Holmes, column 4, lines 5-10.

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The limitations of claims 16-20 are being treated under 35 U.S.C. 112, sixth paragraph.

As such, the structure in the specification is applied to the claims.

In regard to claim 16, Holmes discloses *a. first generating means for generating a first service request using a first one of a plurality of protocols; b. second generating means for generating a second service request and different one of a plurality of protocols; c. transferring means responsively coupled to said generating means for transferring said first service request and said second service request via a publicly accessible digital data network; d. adapting means responsively coupled to said publicly accessible digital data network for adapting said first service request and said second service request to a standardized protocol using a different one of a plurality of adapters to convert said first service request and said second service request; and e. processing means responsively coupled to said adapting means for processing said first service request and said second service request via a generic gateway.* The limitations of claim 16 are substantially the same as the limitations of claim 1. The rejection of claim 1 is used against claim 16.

In regard to claim 17, Holmes is applied as in claim 16. Holmes further discloses *means responsively coupled to said processing means for transferring said first service request and said second service request to an end service provider via a plurality of connectors.* Holmes accepts data and converts it between protocols during delivery of the message. See Holmes, column 3.

In regard to claim 18, Holmes as applied in claim 17 further discloses *wherein said one of said plurality of adapters corresponds to said one of said plurality of connectors.* The limitations of claims 17-18 are substantially the same as the limitations of claim 2. The rejection of claim 2 is applied against claims 17-18.

In regard to claim 19, Holmes is applied as in claim 18. Holmes further discloses *said publicly accessible digital data communication network is the Internet*. See Holmes, column 4, lines 5-10.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes.

In regard to claim 4, Holmes has taught the services of a *generic gateway* and teaches a middleware environment as shown in the rejections of claims 1 and in Holmes, column 4, lines 1-10. Holmes has not specifically stated that these elements were present in an Industry Standard Server housing. However, it is well known to one of ordinary skill in the art that computer parts are highly interchangeable. It would have been obvious to one of ordinary skill in the art to put any portion or combination of the elements in the Holmes invention in any type of housing, including an “Industry Standard Server” housing, in order to fit the space and power requirements of the elements in question.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes in view of Gibson et al. (US 5,758,351).

In regard to claim 5, Holmes failed to disclose the use of Visual Basic. However, Gibson in column 8, lines 3-15 discloses the use of Visual Basic as a programming language tool for use in implementing a request system for use in server environments. Therefore, it would be obvious to one of ordinary skill in the art to use any programming language such as Visual Basic with Holmes to allow for flexibility in programming and server environments.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes in view of Gibson.

In regard to claim 20, Holmes failed to disclose the use of C++. However, Gibson in column 8, lines 3-15 discloses the use of C++ as a programming language tool for use in implementing a request system for use in server environments. Therefore, it would be obvious to one of ordinary skill in the art to use any programming language such as C++ with Holmes to allow for flexibility in programming and server environments.

(10) Response to Argument

1. Appellant argues that claims 1-3 and 16-19 are not unpatentable under 35 U.S.C. 101 as directed to non-statutory subject matter.

Claim 1 refers to a data processing system. The data processing system includes a first client workstation, an enterprise server, a second client work station, and a generic gateway.

Claim 2 further includes adapters interposed between the gateway and the client workstations.

Claim 3 further includes the Internet. Claim 16 is an apparatus claim comprising a first generating means, a second generating means, a transferring means, an adapting means, and a processing means.

A data processing system does not necessarily limit itself to hardware embodiments.

Appellant's specification gives evidence that supports the position that a client workstation is not limited to hardware embodiments. Original specification, page 7, line 5 discusses a "web based work station". A "web based work station" teaches one of ordinary skill that this is a software embodiment.

The adapters between the gateway and the client workstations are not hardware embodiments. Applicant claims the adapters convert formats into a single input format. The conversion is a software function.

Appellant's specification supports the position that a server is not limited to hardware embodiments. Figure 4, item 235 presents a "web server" which is a software module. Figure 4, item 358, is a software DCOM server module. Figure 4, item 360 is a CORBA server software module. Figure 5, item 214 teaches the Web server is not a hardware server, but is a server software program such as Microsoft IIS or Netscape (Fasttrack or Enterprise), which are both software packages. Original specification, page 14, lines 13-14 refer to a client communicating with "an associated Server application".

The specification discloses that Appellant's invention is "presented largely in terms of algorithms and symbolic representations of operations." Original specification, page 11, lines 2-4.

When all of the specification's evidence is considered, along with the broadest reasonable interpretation of a client work station as a software module, a data processing system as a software system, a server as a software module, the conversion adapters as software modules, and the transferring steps as software modules, under a totality of the circumstances test it is apparent that Applicant's invention is broadly claimed to encompass software embodiments. Appellant attempts to disavow the statements of controlling law which specifically state that software cannot exist on its own as patentable subject matter without an appropriate storage medium, and that patentable subject matter must be confined to the four statutory classes of invention. Under all of these considerations, it is clear that Appellant's claims are broadly recited

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as software *per se* and as such are not considered statutory subject matter under the definitions put forth by the U.S. Supreme Court or the U.S. Court of Appeals for the Federal Circuit.

2. Appellant argues that claims 1-3 and 16-19 are not unpatentable under 35 U.S.C. 102(b) as being anticipated by Holmes.

Appellant argues that no conversion exists between the client work station format and the enterprise server format. "Registry determines the appropriate Messaging Product 106 and converts the message into the proprietary protocol of this Messaging Product. In some situations, Registry may actually serve as the Messaging Product; in these cases, it will convert the message to the proprietary protocol of the network transport 108 (i.e., SNA LU6.2, TCP/IP, etc.)." Holmes, column 3, lines 31-38. The Holmes system accepts Registry requests under a client's protocol, encapsulates the requests and converts them into a proprietary protocol for delivery to the server by converting again to a message appropriate for the server application.

Appellant argues that Holmes fails to disclose responding using an enterprise protocol which is not one of said plurality of protocols. "Registry determines the appropriate Messaging Product 106 and converts the message into the proprietary protocol of this Messaging Product. In some situations, Registry may actually serve as the Messaging Product; in these cases, it will convert the message to the proprietary protocol of the network transport 108 (i.e., SNA LU6.2, TCP/IP, etc.)." Holmes, column 3, lines 31-38.

Appellant argues that no adapters exist for conversion between the client work stations and the generic gateway. When the conversion of the data happens in Holmes, it happens because of a software "adapter" which converts the data.

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Appellant makes a blanket argument in regard to claim 3, without addressing any further limitations that are not present in Holmes.

Appellant makes a blanket argument that the rejection of claim 1 is not applicable to claim 16, without stating how the rejection of claim 1 does not meet the limitations of claim 16. Appellant apparently wishes that the Office state on the record the words that "The limitations of claim 16 are being treated under 35 U.S.C. 112, sixth paragraph" as stated in MPEP 2181. However, MPEP 2181 and *In re Donaldson* reiterate that "claim language should be given its broadest reasonable interpretation." "The *Donaldson* decision thus does not substantially alter examining practice and procedure relative to the scope of a search....if a prior art reference teaches identity of function to that specified in a claim, then under *Donaldson* an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function". MPEP 2181. In the case of claim 16, applying the test of MPEP 2183, the prior art elements of Holmes as applied in claim 1 perform the identical function specified in claim 16 in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification. This test is clearly set out in *Graver Tank & Mfg. Co. v. Linde Air Products* as defining the doctrine of equivalents, but as per MPEP 2183 is equally applicable to analysis under 35 U.S.C. 112, sixth paragraph.

Appellant argues that Holmes failed to disclose the connectors in claim 17.

Appellant argues that Holmes failed to disclose the relationship of the connectors to the adapters in claim 18. When the conversion of the data happens in Holmes, it happens because of

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a software "adapter" which converts the data. The connectors are merely the underlying software threads which move the data to the conversion modules.

Appellant makes a blanket argument concerning claim 19.

3. Appellant argues that claim 4 is not obvious over Holmes.

Claim 4 requires that a housing be added to the system. Putting a computer system in a housing is so well known that it has been in existence since the 1940s, when ENIAC was created. Appellant further argues that no generic gateway or middleware are present in Holmes. The title of Holmes is "Registry Communications Middleware." The conversion of the data in the registry is the "generic gateway."

4. Appellant argues that claims 5 and 20 are not unpatentable under 35 U.S.C. 103(a) as being not obvious over Holmes in view of Gibson.

As an initial statement, new grounds of rejection were appropriate for claims 5 and 20, since Appellant amended these claims to change their scope before the final rejection.

In regard to claim 5, Appellant makes a blanket argument that the combination of Holmes and Gibson cannot teach the use of Visual Basic. As the rejection states, any programming language could be used in a server environment, and Gibson teaches that Visual Basic is used to implement a request system in a server environment.

In regard to claim 20, Appellant makes a blanket argument that the combination of Holmes and Gibson cannot teach the use of C++. As the rejection states, any programming language could be used in a server environment, and Gibson teaches that C++ is used to implement a request system in a server environment.

(11) Related Proceeding(s) Appendix

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No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jeffrey R. Swearingen/

Examiner, Art Unit 2445

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Conferees:

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